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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,135	10/15/2003	Ivan Osorio	011738.00133	8261
22908	7590	05/31/2006		
BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606			EXAMINER SMITH, STEPHANIE R	
			ART UNIT 3762	PAPER NUMBER

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/687,135

Applicant(s)

OSORIO ET AL.

Examiner

Stephanie Smith

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3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>27 April 2004</u> <del>18 June 2004</del> <u>23 November 2004</u>         | 6) <input type="checkbox"/> Other: _____                                    |
| <u>14 June 2004</u>  |   |

## DETAILED ACTION

### ***Information Disclosure Statement***

The information disclosure statements (IDSs) submitted on April 27, 2004, June 18, 2004, and November 23, 2004 were filed after the mailing date of the application on October 15, 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 12-13, 17, 20, 22-31, and 33-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Mann (U.S. 2001/0034542). Referring to claims 1, 20, 25-26, and 34, Mann teaches a system and method for programming the magnitude of electrical stimuli generated and applied by a spinal cord stimulator (see page 2, paragraph 9). The spinal cord stimulator includes an external programmer that downloads whatever programming data the IPG needs to generate stimulating pulses, such as pulse width, pulse amplitude, and pulse rate (see page 5, paragraph 43). A

clinician programs the stimulation ranges by applying stimulation to the patient through different electrode sets and determining the stimulation settings for the sets such as minimum perceived threshold level and maximum perceived threshold level (see page 2, paragraphs 11 and 12). Thereafter, the stimulus applied through the electrode is adjusted according to the threshold levels (see page 2, paragraph 12). Referring to claims 6 and 27, the electrode sets are named and the thresholds associated with the electrode sets are stored (see page 5, paragraph 48 and page 3, paragraph 20). Regarding claims 2-4 and 35, Mann teaches that the magnitude of the stimulus can only be increased up to the maximum tolerable level perceived by the patient (see page 7, paragraph 56). Further, the patient is able to compare which electrode set produces the best result (see page 7, paragraph 57).

With regards to claims 5 and 36, the current distribution is varied over the electrodes as they are added or subtracted into the electrodes that act as the anodes and cathodes (see page 7, paragraphs 58-71). Referring to claims 12 and 13, the treatment is comprised of an electrode configuration, a stimulation parameter, a therapy level, and a level of tolerability. Additionally, the stimulation parameter is selected from pulse width, pulse amplitude, and pulse rate (see page 5, paragraphs 45, 47-48). Referring to claims 17 and 33, Mann teaches a system and method that determines the tolerable levels of stimulation that will not deliver therapy at a magnitude greater than the maximum tolerable threshold (see claim 16).

Referring to claims 22-24, Mann teaches electrical stimulation to the spinal cord using an implanted system with an external controller as described above. With

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reference to claims 28-31, Mann teaches multiple electrode sets, each labeled, with associate threshold data for the minimum perceived data and maximum tolerable data (see page 5, paragraphs 47-48). Mann further teaches that a subset of the possible electrode configurations may be measured and from such measurements estimates may be made of the unmeasured thresholds with accuracy (see page 3, paragraphs 17-19).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann. Mann teaches the method and device described above, but does not teach

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the user labeling the electrode configurations or treating for epilepsy, Parkinson's disease, essential tremor, dystonia, multiple sclerosis, anxiety, mood disorder, sleep disorder, or psychiatric disorder. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the neurostimulation system and method as taught by Mann with the label from the user or to treat various nervous system disorders, because Applicant has not disclosed that the label from the user or treating various nervous system disorders provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the label from the device or treating the central nervous system as taught by Mann, because it provides a means by which the user can identify different stimulation settings and it treats any disorder originating in the central nervous system and since it appears to be an arbitrary design consideration which fails to patentably distinguish over Mann. Therefore, it would have been an obvious matter of design choice to modify Mann to obtain the invention as specified in claims 7-11 and 21.

Claims 14 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann in view of Whitehurst et al (U.S. 2004/0015205). Mann teaches the system and method described above, but do not teach determining the surface area of the electrodes or the charge density, or using these parameters to determine if therapy should be delivered. Whitehurst et al. teach that the electrodes must have a relatively large surface area in order to maintain safe levels of charge density and current density (see page 3, paragraph 46). Therefore, it would have been obvious to one skilled in the

art at the time the invention was disclosed to combine the system and method for neurostimulation taught by Mann with the electrodes with a large surface area to maintain safe levels of charge density.

Regarding claims 15 and 16, Mann in view of Whitehurst et al. discloses the claimed invention except for the calculation of charge density and current. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the neurostimulation system and method taught by Mann in view of Whitehurst et al, with the calculations for charge density and current since it was known in the art that the equations disclosed by the Applicant are used to calculate current and charge density.

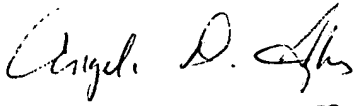
Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann in view of Esteller et al (U.S. 6594524). Mann teaches the neurostimulation system and method described above, but does not teach drug infusion. Esteller et al. teach treating neurological disorders by drug infusion that is activated to deliver a minimal amount of drug (see claims 7 and 65). It would be obvious to use drug infusion to treat neurological disorders because certain drugs can correct chemical imbalances in the body. Therefore, it would have been obvious to one skilled in the art at the time the invention was disclosed to combine the neurostimulation system and method taught by Mann with the drug infusion taught by Esteller et al. in order to correct a chemical imbalance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephanie Smith whose telephone number is 571-272-2834. The examiner can normally be reached on Monday-Friday between 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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